

## **REMARKS/ARGUMENTS**

### **Administrative Overview**

Claims 1-6, and 25-40 were pending in this application prior to entry of this amendment. Claims 33-40 were previously withdrawn, are canceled herein without prejudice, and are currently being pursued in related U.S. Application No. 12/082,393, which is pending.

Without acquiescing to the rejections, Applicant:

- (i) amends independent claim 1 to include the limitation of dependent claim 2;
- (ii) amends independent claim 25 to include the limitation of dependent claim 28 (but not intervening claim 27);
- (iii) amends dependent claim 5 to adjust claim dependency in light of the cancellation of claim 2;
- (iv) adds new dependent claims 41-43, which are clearly supported in the original specification, for example, at page 8, lines 1-4;
- (v) cancels without prejudice dependent claims 2 and 28; and
- (vi) cancels without prejudice previously withdrawn claims 33-40.

No new matter is added by any of the amendments. Following entry of this paper, claims 1, 3-6, 25-27, and 29-32, and 41-43 are pending.

### **Interview Summary**

Applicant thanks the Examiner for the telephonic interview between Examiner Steele and former representative of Applicant, Richard Samuel. The cited art was discussed (Messier and Pike), and Applicant submitted a proposed amendment to claim 1, but the Examiner argued such amendment would be rejected under 35 USC 112 1<sup>st</sup> paragraph constituting new matter. Agreement with respect to the claims was not reached.

### **The pending claims are non-obvious under 35 USC 103(a), in light of the cited art**

The Office Action argues that the Declaration under 37 CFR 1.132 filed September 28, 2009, is insufficient to overcome the obviousness rejection (35 USC 103(a)) of claims 1-6 and 25-32 based upon Messier in view of Pike as set forth in the last Office action because “[t]he evidence is not commensurate with the scope of the claims.” The Examiner states, “[a]n

amendment to the claims to be commensurate in scope with the evidence would be sufficient to overcome the rejection over Messier in view of Pike.”

With regard to independent claim 1, the Examiner appears to argue that both (i) the structure of the dielectric carrier and (ii) the choice of carrier material is too broad, in light of the Declaration. Applicant respectfully traverses the rejections. The Declaration demonstrates the surprising finding that adding an iodinated resin stabilizes the electrical charge applied to a nonwoven electret filter media while, at the same time, provides a high level of antimicrobial efficacy to the resultant media. Since instant claim 1 recites an electrostatically-charged, non-woven porous dielectric carrier incorporating an iodinated resin, the Declaration is sufficient to demonstrate non-obviousness of the subject matter of claim 1 in light of prior art which teaches against incorporating antimicrobial agents into a nonwoven filter media due to charge deterioration. It is not necessary that every embodiment falling within the scope of the claims be experimentally proven to be operative.

With regard to (i) structure of the dielectric carrier, the experiments described in the Declaration of September 22, 2009, involve a structure of two layers of dielectric material sandwiching a layer of dielectric material that contains the iodinated resin. This structure was chosen as a means of providing a fair comparison between the samples that contained iodinated resin and the samples that did not contain iodinated resin; i.e., for the samples that contained iodinated resin, the structure allowed measurement of static charges on a surface identical to that of the control samples (there was no iodinated resin on the surface). This structure was one of many that could have been chosen to demonstrate the combined charge-stabilizing effect and antimicrobial effect of the iodinated resin, and there is no evidence that this specific structure is critical to the synergistic effect established by the experiments.

With regard to (ii) choice of carrier material, the experiments described in the Declaration of September 9, 2009, employ one layer of 20-XP media sandwiched between two layers of 35-ZPN media. Both 20-XP media and 35-ZPN media are made of polypropylene and were chosen for use in the experiments as a typical dielectric carrier. There is no evidence that the use of the specific 20-XP and 35-ZPN media is critical to the synergistic effect established by the experiments, nor is there any evidence that the dielectric carrier must be a meltblown web, or must be polypropylene. It is clear that other forms and types of materials could be used as the

dielectric carrier and still demonstrate the charge-stabilizing effect and antimicrobial effect of the iodinated resin.

The Examiner has found the claims to be enabled, since no rejection under 35 USC 112 has been made. The claims satisfy the enablement requirement because the specification teaches “those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation’.” *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The description in the Declaration is not relevant to a determination of whether or not the specification provides enablement which is commensurate in scope with the claims.

Furthermore, there is no requirement that a Declaration present experimental evidence that every embodiment covered within the scope of the claims be operative. The presence of inoperative embodiments within the scope of a claim does not automatically render a claim non-enabled. The appropriate standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984). In the present case, simple experimentation with various carrier materials and structures could provide such a determination. Furthermore, as noted above, the Examiner has actually found the claims to be enabled by the specification, since no rejection under 35 USC 112 has been made.

With regard to dependent claim 4 and independent claim 25, the Examiner argues the claimed embodiments are not specifically covered by the experiments of the Declaration. Applicant submits that this is irrelevant, since the Declaration demonstrates the surprising finding that adding an iodinated resin stabilizes the electrical charge applied to a nonwoven electret filter media while at the same time providing a high level of antimicrobial efficacy to the resultant media. Since each of claims 4 and 25 recites an electrostatically-charged, non-woven porous dielectric carrier incorporating an iodinated resin, the Declaration is sufficient to demonstrate non-obviousness of the subject matter of claims 4 and 25 in light of prior art which teaches against incorporating antimicrobial agents into a nonwoven filter media due to charge deterioration. Furthermore, as discussed above, it is not necessary that each and every embodiment be proven to be operable, and that, furthermore, this is irrelevant to a determination of non-obviousness under 35 USC 103(a).

Because independent claims 1 and 25 patentably distinguish from the cited art, all of their dependent claims are non-obvious over the cited art, at least for this reason.

Furthermore, Applicant incorporates by reference herein Applicant's arguments on pages 2-5 of the RCE filed on September 25, 2009, traversing the claim rejections under 35 USC 103(a) in the instant case.

Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1, 3, 5-6, 25-27, 29, and 31-32 under 35 USC 103(a) as being allegedly unpatentable over Messier (US 6,224,655) in view of Pike et al. (US 5,873,968), and, Applicant requests reconsideration and withdrawal of the rejections of claims 4 and 30 under 35 USC 103(a) as being allegedly unpatentable over Messier ('655) in view of Pike et al. and further in view of Messier (US 5,639,452).

### **CONCLUSION**

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now pending in the application are respectfully requested.

Should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is cordially invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

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Respectfully submitted for Applicant,



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